

U.S. Pat. Appl. Ser. No. 09/432,338
Attorney Docket No. 10191/1157
Reply to Final Office Action of April 21, 2001

REMARKS

Claim 86 is canceled without prejudice, claims 8 to 82 have been withdrawn based on the prior restriction requirement, and therefore claims 83 to 85 and 87 to 90 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph four of the Final Office Action, claims 83 to 90 were rejected under the first paragraph of 35 U.S.C. § 112 as to the written description requirement.

Claim 86 has been canceled without prejudice to facilitate matters.

It is first noted that the Office bears the initial burden of presenting "evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should "identify the claim limitation not described" and also provide "reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application." (See id.). In this regard, the Office Action does not explain why a person skilled in the art would not recognize the features of claim 83 and claim 88 that a duration of a time window is defined such that a current flowing through the consumer does not exceed a threshold value and that the duration of the time window is reduced when the current is greater than the threshold value. In this regard, the Specification specifically provides the following:

Disconnection of the output stage current during detection of the switching instant is avoided through the procedure according to the present invention. The time window within which the switching instant is detected is *defined* in such a way that detection of the switching instant is possible, yet, the current does not rise to unacceptably high levels.

(See Specification, page 2, lines 1 to 5). In addition, the Specification provides that:

According to the present invention, the duration of the time window is increased starting from a starting value (BMIN) if the current is lower than the threshold value. The duration of the time window is increased until reaching a maximum value (BMAX) for the duration. The duration of the time window is *reduced* if the current is greater than the threshold value.

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(See Specification, page 7, lines 5 to 9).

Thus, the duration of the time window is defined so as to not exceed a threshold value, and the duration of the time window is reduced when the current is greater than the threshold value.

As further regards the written description requirement, as explained above, it is respectfully submitted that the Final Office Action has not satisfied the Office's *initial* burden of presenting "evidence or reasons *why* persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added).

Indeed, the Manual of Patent Examining Procedure itself provides that if an examiner rejects a claim based on the lack of a written description, the examiner should "identify the claim limitation not described" and provide "reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application." (See id.). It is respectfully submitted that the Office Action's arguments and assertions simply do not identify why the rejected claims are not supported by the written description of the present application (and its specification) – which it plainly is, as explained herein.

As stated by the Board in Ex parte Harvey, 3 U.S.P.Q. 2d 1626, 1627 (Bd. Pat. App. Int. 1986) (emphasis added, citations omitted):

Compliance with the written description requirement of Section 112 only requires that appellant's application contain sufficient disclosure, *expressly or inherently*, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, *rather than the presence or absence of literal support in the specification for the claimed language*.

Likewise, as stated by the Board in Ex parte Sorenson, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. Int. 1987) (emphasis added):

[W]e are mindful that appellant's specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *The test is whether the originally filed*

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specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed. . . . Moreover, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in appellant's specification disclosure a description of the invention defined by the claims.

In particular, the Sorenson Board, noting that the examiner only essentially stated that the claim expressions at issue did not "appear in the original disclosure" and that the claim expressions were therefore "not adequately supported by the few specific compounds in the specification", found that the examiner had not met his initial burden of "presenting evidence why a person having ordinary skill in the art would not recognize in appellant's specification a description of the invention defined by the claims" -- and that the "only reasoning presented" that the Board could discern was an "example of *ipse dixit* reasoning, resting on a bare assertion by the Examiner".

In view of all of the foregoing, it is respectfully submitted that the Final Office Action's arguments and assertions do not satisfy the evidentiary and judicial standards discussed above, and it is respectfully submitted that the Final Office Action does not establish a prima facie written description case with respect to the present application. It is therefore respectfully submitted that the present application does satisfy the written description requirement of 35 U.S.C. § 112, especially in view of the further discussions herein as to the enablement and new matter rejections. Accordingly, it is respectfully submitted that the "written description" rejection of the claims should be reversed.

It is therefore respectfully submitted that the Office Action's arguments and assertions simply do not explain why the subject matter of claim 83 and claim 88 is not supported by the written description of the present application -- which it plainly is for the reasons discussed herein, so that claim 83 and claim 88 are allowable.

Claims 84, 85 and 87 depend from claim 83, and are therefore allowable for the same reasons as claim 83.

Claims 89 and 90 depend from claim 88, and are therefore allowable for the same reasons as claim 88.

Furthermore, while the specification as originally filed must provide a statutorily sufficient written description of the claimed subject matter to a person having ordinary skill, it does not matter exactly how this is done so long as the written description requirement is

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satisfied. To determine whether the written description requirement is satisfied, the specification as a whole must be considered. See In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (citing In re Smith, 481 F.2d 910, 914, 178 U.S.P.Q. 620, 624 (C.C.P.A. 1973)).

In this regard, the present application provides, for example, that a "time window within which the switching instant is detected is defined in such a way that detection of the switching instant is possible, yet, the current does not rise to unacceptably high levels," and further provides that a "duration of the time window is reduced if the current is greater than the threshold value." (See Specification, page 2, lines 1 to 5 and page 7, lines 5 to 9). Accordingly, it is respectfully submitted that a person having ordinary skill in the art would understand (especially in view of the specification) that the duration of the time window is defined as to not exceed a threshold value, and that the duration of the time window is reduced when the current is greater than the threshold value.

In view of all of the foregoing, it is respectfully submitted that the Final Office Action's arguments and assertions of paragraph four (4) do not satisfy the evidentiary and judicial standards discussed above, and it is therefore respectfully submitted that the Final Office Action has not established even a prima facie written description case as to the present application. It is therefore respectfully submitted that the present application does satisfy the written description requirement of 35 U.S.C. § 112, so that claims 83 to 90 are allowable.

With respect to paragraph six (6), claims 83 to 90 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. It is respectfully submitted that these claims are definite for at least the following reasons.

Claim 86 has been canceled without prejudice to facilitate matters.

Claim 83 and claim 88 provide that the duration of the time window is defined so as to not exceed a threshold value, and further provide that the duration of the time window is reduced when the current is greater than the threshold value. The remarks discussed herein as to "defining" the duration of the time window and "reducing" the duration of the time window (as regards the written description rejections) are also referred to here as to the indefiniteness rejections. As described in the specification, a "time window within which the switching instant is detected is defined in such a way that detection of the switching instant is possible, yet, the current does not rise to unacceptably high levels," and a "duration of the time window is reduced if the current is greater than the threshold value." (See Specification, page 2, lines 1

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to 5 and page 7, lines 5 to 9). Accordingly, claims 83 and 88 are definite, as are their dependent claims.

As regards claim 86, while the rejection may not be agreed with, to facilitate matters, claim 86 has been canceled without prejudice.

In view of at least the foregoing, it is respectfully submitted that the claims are definite.

With respect to paragraph nine (9), claims 83 to 90 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,592,921 ("Rehbichler").

Claim 86 has been canceled without prejudice to facilitate matters.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 83 provides a method of activating an electromagnetic consumer having a movable element, which includes: determining within a time window a switching instant at which the movable element has reached a certain position, defining a duration of the time window so that the current flowing through the consumer during the time window does not exceed a threshold value, and *reducing the duration of the time window if the current is greater than the threshold value.*

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Claim 88 provides an arrangement for activating an electromagnetic consumer having a movable element, which includes: a determining arrangement to determine within a time window a switching instant at which the movable element has reached a certain position, and to define a duration of the time window so that the current flowing through the consumer during the time window does not exceed a threshold value, and *a reducing arrangement to reduce the duration of the time window if the current is greater than the threshold value.*

In contrast the "Rehbichler" reference purportedly concerns a method and a device for actuating an electromagnetic load for influencing metering of fuel in an internal combustion engine. The electromagnetic load is connected with a switch that is supplied with an actuation signal. For identification of a switching time of the electromagnetic load, a parameter which characterizes the actuation signal is evaluated. (Abstract, lines 1 to 7). Furthermore, the "Rehbichler" reference states that in a first time period, until signal CHIL reaches a higher value, a current controller 140 adjusts the current flowing through the solenoid valve to a desired value IS1 prescribed by the control unit. The control unit opens switching means 110 when an upper current threshold is exceeded. Lower current threshold is fluid and is achieved via deactivation of switching means 110 for a specific time TP. When the current value is exceeded the switch opens and after the prescribed time TP the switch closes again. The current I through the solenoid valve oscillates between a prescribed upper threshold and a lower value. (Col. 4, lines 12 to 24).

Accordingly, the "Rehbichler" reference does not identically disclose (or even suggest) the feature in which a duration of a time window is reduced when the current exceeds a threshold value, as provided for in the context of claims 83 and 88. The "Rehbichler" reference merely indicates that until signal CHIL reaches a higher value, the current flowing through the solenoid valve is adjusted to a desired value IS1 prescribed by a control unit such that when the current value is exceeded the switch opens and after a prescribed time TP the switch closes again. Nothing in the "Rehbichler" reference identically discloses the claim feature of reducing a duration of a time window when the current is greater than a threshold value, as recited in the context of claims 83 and 88, as presented.

For the foregoing reasons, the "Rehbichler" reference does not anticipate the subject matter of claims 83 and 88, as presented.

Claims 84, 85 and 87 depend from claim 83, and are therefore allowable for the same reasons as claim 83.

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Claims 89 and 90 depend from claim 88, and are therefore allowable for the same reasons as claim 88.

It is therefore respectfully submitted that the rejections of claims 83 to 88 should be withdrawn.

With respect to paragraph ten (10), claims 83 to 90 were rejected under 35 U.S.C. § 102(b) as anticipated by United Kingdom Patent Application No. GB 2 311 559 ("Fischer").

As regards anticipation law, the above discussion is referred to here.

Claim 86 has been canceled without prejudice to facilitate matters.

Claim 83 provides a method of activating an electromagnetic consumer having a movable element, which includes: determining within a time window a switching instant at which the movable element has reached a certain position, defining a duration of the time window so that the current flowing through the consumer during the time window does not exceed a threshold value, and *reducing the duration of the time window if the current is greater than the threshold value.*

Claim 88 provides an arrangement for activating an electromagnetic consumer having a movable element, which includes: a determining arrangement to determine within a time window a switching instant at which the movable element has reached a certain position, and to define a duration of the time window so that the current flowing through the consumer during the time window does not exceed a threshold value, and *a reducing arrangement to reduce the duration of the time window if the current is greater than the threshold value.*

In contrast the "Fischer" reference purportedly concerns a method and an apparatus for controlling an electromagnetic switching member with an excitation winding and a movable armature such that within a time window, a current is evaluated to detect a switching instant at which the armature reaches a new end position. The time window is enlarged when no reliable switching instant is detected within the time window. (Page 2, lines 1 to 7). Furthermore, the "Fischer" reference states that "[t]he measurement window, in particular the beginning FB of the window, cannot be chosen to be as large as desired, since the beginning FB of the window fixes the instant at which the current is regulated down to the holding current" and "[i]f this current is chosen to be too early, the valve does not switch sufficiently rapidly or even not at all." (Page 6, lines 8 to 12).

Accordingly, the "Fischer" reference does not identically disclose (or even suggest) the feature of a duration of a time window being reduced when the current exceeds a threshold

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value, as provided for in the context of claims 83 and 88. The "Fischer" reference merely indicates that a measurement window cannot be as large as desired because the beginning FB of the window fixes the instant at which the current is regulated down to the holding current. Nothing in the "Fischer" reference identically discloses (or suggests) the claim feature of reducing a duration of a time window when the current is greater than a threshold value, as recited in the context of claims 83 and 88, as presented.

For the foregoing reasons, the "Fischer" reference does not anticipate the subject matter of claims 83 and 88, as presented.

Claims 84, 85 and 87 depend from claim 83, and are therefore allowable for the same reasons as claim 83.

Claims 89 and 90 depend from claim 88, and are therefore allowable for the same reasons as claim 88.

It is therefore respectfully submitted that the rejections of claims 83 to 88 should be withdrawn.

It is therefore respectfully submitted that claims 83 to 85 and 87 to 90 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 83 to 85 and 87 to 90 are allowable. It is therefore respectfully requested that the rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Dated: 7/13/2004

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